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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,438	12/20/2001	Allison Stoltz	52493.000230	5099

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EXAMINER

GRAYSAY, TAMARA L

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,438

Applicant(s)

STOLTZ, ALLISON

Examiner

Tamara L. Graysay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

EA

DETAILED ACTION

Drawings

1. The drawings are objected to because of the following:
 - a. They fail to comply with 37 CFR 1.84(m) because the shading (Fig.3) does not aid in understanding the invention and reduces legibility.
 - b. They fail to comply with 37 CFR 1.84(p)(3) because the reference characters are not at least .32cm (1/8 inch) in height.
 - c. They fail to comply with 37 CFR 1.84(u)(2) because the view numbers are not larger than the numbers used for reference characters.
 - d. Figure 1, reference character 100 is not accompanied by a lead line.
 - e. Figure 2, the box describing reference character 160 is not consistent with the description mentioned in the specification. Specifically, “potential consequences” should be expected risk.
 - f. Figure 3, reference characters “300” associated with the client stations should be 310 as mentioned in the specification. Reference character 320 should have an associated lead line.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

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be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. The disclosure is objected to because of the following informalities:

- a. Page 4, line 27, "Figure 2" should be Figure 3.
- b. Page 16, line 27, "10" should be 310.
- c. Page 20, line 12, "250" should be 350.
- d. Page 21, line 1, "30" should be 330.
- e. Page 21, lines 19 and 20, "40" and "440" should be 340.
- f. Page 22, line 13, after "be" the words used to should be inserted to correct a grammatical problem.

Appropriate correction is required. No new matter should be added.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 7-9 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification is not enabled for the embodiment including the occurrence index. Page 11, line 22, <10,001 is included in the range of 10,000 – 100,001; and, line 25, <500,00 is unclear, as is 500,00-2M (also mentioned at the bottom of page 11 and the upper half of page 20). Page 14, line 28, the product development detection index equation numerator is not correlated to the responses presented as the answers for Business Units #1 and #2. Page 15, line 2, the state product filings detection index numerator is not correlated to the response presented as the answers for Business Units #1 and #2. Page 15, lines 18-20, the total risk scores do not correlate to the detection and severity risk indices presented in the specification.

Due to the inconsistencies in the specification, including but not limited to overlapping ranges and the unconventional use of commas, applicant has failed to describe the invention to enable one skilled in the art to make and/or use the invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 7-9 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The claims are indefinite insofar as the subject matter of the claim cannot be determined in light of the lack of enablement rejection made above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groth (article, Common-sense risk assessment).

Regarding claims 1 and 10-12, Groth discloses a method of evaluating risk that includes presenting a series of questions relating to at least one business category (survey, e.g., p.12, right col.); soliciting a response for each question (people whose experience with a project is greatest should complete the survey, e.g., p.13, left col.); and prioritizing the category based on the responses (the questions stimulate thoughts and draw on the knowledge and experience of the analyst, e.g., p.13, right col.) and at least one standard severity risk index (the summary score captures the result of the analysis, e.g., p.13, right col.; the total score is used to evaluate the relative merit of projects, e.g., p.13, right col.).

Groth lacks the use of a computer network for performing the method, as nominally recited in the body of the claim. However, merely using a computer to automate a known process does not by itself impart nonobviousness to the invention. See *Dann v. Johnston*, 425

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U.S. 219, 227-30, 189 USPQ 257, 261 (1976); In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify automate the process disclosed in Groth such that the method is performed via a computer network.

Further regarding system claims 10-12, the examiner takes Official notice that the use of modules to perform various computer functionalities is well known in the computer art to increase the speed and accuracy of data analysis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Groth to include modules for implementing the automated process in order to increase the speed and accuracy of the analysis.

Regarding claims 2-4 and 13-15, the claimed response formats and scoring are old and well known expedients of measurement. A person skilled in the art of risk management and statistical analysis is familiar with various formats and scoring techniques used in surveys. Thus, selection of yes/no, 1-10, or some other format, would have been within the level of ordinary skill in the field of risk management and statistical analysis. In Groth, the risk management survey is used to determine a risk level and to compare opportunities and in doing so utilizes a scale of 0-5, for example (p.14). Therefore, the particular format and scoring of yes/no and 1-10 would have been obvious to one of ordinary skill in the art at the time the invention was made, in order to establish a comparative quantification of the results.

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Regarding claims 5 and 16, the severity risk index (Groth's summary score) corresponds to a particular business category (business or financial, p.12, left col. and depicted in Table II, for example).

Regarding claim 6 and 17, the use of indices to normalize the responses to survey questions or other types of data is well known in the art of statistical analysis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Groth to include the step of determining an index based on the number of questions, the responses, and the number of respondents in order to normalize the data for the purpose of comparing respondents and/or survey results.

7. Claims 7-9 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Groth (article, Common-sense risk assessment) in view of Dzinkowski (article, Rulers of risk management).

Regarding claims 7 and 18, Dzinkowski teaches the evaluation of various categories of operational risk including compliance risk (p.40, right col.). In the field of risk management and statistical analysis, the corollary to compliance risk evaluation is noncompliance risk evaluation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify Groth to include the step of determining an occurrence index based on noncompliance consequences, such as suggested by the compliance risk evaluation of Dzinkowski, in order to normalize the consequences of noncompliance throughout the business.

Regarding claims 8 and 19, prioritizing the business category based on a total risk score is suggested in Groth, which uses a total score or rating scheme to prioritize the business categories or projects.

Regarding claim 9 and 20, Groth discloses ranking results including business categories or projects (the total risk score is useful in evaluating the relative merit of projects, p.13, right col.).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Banham (article, Managing risk in the 21st century) teaches monitoring all aspects of company operations (page 32), technology improvements increasing speed within the business community (page 38), the level of skill of a risk manager (page 42).
- Lenard (article, An analysis of fuzzy clustering and a hybrid model for the auditor's going concern assessment) teaches total risk as an accumulation of operating risk, business risk, debt risk, and future liquidity risk (page 866); application of the total risk score to a risk management (page 866-867); use of yes/no questions in a survey (e.g., page 867); and use of more accurate and consistent expert systems to assist auditors in decision process (page 867).

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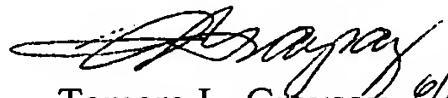
- Takemura (JP-2001046381-A) teaches risk analysis by responding to questions and calculating a risk value.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (571) 272-6728.

The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tamara L. Graysay 9/13/05
Examiner
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